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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,766	04/16/2004	David M. Binder	7226-208	8796

27383 7590 07/21/2005

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NEW YORK, NY 10019-6131

EXAMINER

GIBSON, KESHIA L

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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20050711

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Office Action Summary

Application No.

10/825,766

Applicant(s)

BINDER ET AL.

Examiner

Keshia Gibson

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-12, 14, 15 and 28-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6-12, 14, 15 and 28-42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/2/2005 have been fully considered but they are not persuasive. Applicant has argued:

1) Docter's hydrogels, which are hydrophilic, are not equivalent to the claimed invention's silicone gels, which are hydrophobic. Examiner grants this distinction.

2) The carrier of Docter is elastic but not supportive. However, the object that the carrier is to support and the degree to which it is to support the object has not been adequately stated in the claim language. The carrier can be considered to support the gel layer. Furthermore, since the bandage is wrapped around a body part, the bandage is considered to provide musculo-skeletal support of some degree- even if only minimal.

3) The gel layer of Docter is not equivalent to that the of the silicone layer of the claimed invention since the silicone gel layer of the claimed invention will not break down in the presence of water. Examiner acknowledges this difference in the gel layers; however,

4) The teachings of Pocknell do not cure the deficiencies of Docter; however, as stated in the previous Office Action, Pocknell provides adequate motivation for modifying the bandage of Docter to provide for the deficiencies of Docter.

Thus, despite applicant's arguments, the Docter and Pocknell are still considered to prior art that is applicable to the limitations set forth in the new set of amended claims (Claims 6-12, 14-15, and 28-42) as presented in the previous Office Action and modified and presented again, in view of applicant's amendments, below.

Claim Objections

2. Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of dependent Claim 8 are already present in parent Claim 6; it is suggested that Claim 8 be cancelled.

Allowable Subject Matter

3. The indicated allowability of claims 10, 11-12, 14-15, and 38-42 is withdrawn in view of the new grounds of rejection presented below.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Docter (US 6,143,946).

In regard to Claim 10, Docter discloses a stretchable, supportive wrap 10 (column 2, lines 17-24). The wrap 10 has a gel layer 14, a stretchable carrier 12, and closure strips

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16 (column 2, lines 17-24). Hook-and-loop type straps 16 are added to the elastic layer 12 of the wrap 10 to allow the bandage 10 be wrapped and secured around a body part by connecting elements 18 of the straps 16 to the elastic layer 12 (column 3, lines 8-22).

Thus, the elastic layer of Docter is considered to be the stretchable loop portion of a hook-and-loop type fastener. The Examiner considers the bonded surfaces of the gel layer 2 and carrier layer 3 to be the respective adhesion surfaces of each material.

Furthermore, applicant is advised that the method of forming the product is not relevant to the issue of patentability of the product itself. Therefore, this limitation has not been given patentable weight.

Docter does not expressly disclose a method of applying the wrap; however, it has been held that the prior art inherently performs a claimed method when that prior art meets the structural limitations of the article of the claimed invention and is used in normal and usual operation (see MPEP 2112.02). It is considered normal and usual operation to stretch a stretchable wrap around a portion of the body then secure the wrap in a closed position with closure strips or fasteners. (Also see Docter's disclosure for mention of this operation in column 3, lines 8-14). Therefore, Docter anticipates the method of the claimed invention.

In regard to Claim 11, Claim 11 is the same as Claim 10 except for the limitation the preamble and part (a) of the claim that the method provides a skin treatment for a portion of a body in need of treatment. As discussed for Claim 10, Docter does not expressly disclose a method of applying the wrap; however, it has been held that the prior art inherently performs a claimed method when that prior art meets the structural

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limitations of the article of the claimed invention and is used in normal and usual operation (see MPEP 2112.02). It is considered normal and usual operation to stretch a stretchable wrap around a portion of the body then secure the wrap in a closed position with closure strips or fasteners. (Also see Docter's disclosure for mention of this operation in column 3, lines 8-14). Therefore, Docter anticipates the method of the claimed invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-9, 12, 14-15, 28-35, 47-40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pocknell (US 4,991,574) in view of Docter (US 6,143,946).

In regard to currently amended Claim 6, Pocknell discloses a stretchable, supportive bandage comprising a gel layer 2 bonded to a stretchable carrier 3 (column 1, lines 57-61; Figure 1). Examiner considers the bonded surfaces of the gel layer 2 and carrier layer 3 to be the respective adhesion surfaces of each material. Furthermore, applicant is advised that the method of forming the product is not relevant to the issue of patentability of the product itself. Therefore, this limitation has not been given patentable weight. Pocknell further discloses that the gel layer 2 comprises silicone (column 1,

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lines 57-61; Figure 1). Pocknell does not disclose that the carrier is a stretchable loop portion of a hook and loop fastener.

Docter teaches a bandage 10 comprising an elastic carrier layer 12 and a gel layer 14.

Docter teaches adding hook-and-loop type straps 16 to the elastic layer bandage to allow the bandage 10 be wrapped and secured around a body part by connecting elements 18 of the straps 16 to the elastic layer 12 (column 3, lines 8-22). Thus, the elastic layer of Docter is considered to be the stretchable loop portion of a hook-and-loop type fastener. Pocknell and Docter are analogous art because they are from the same field of endeavor: bandages comprising elastic and gel layers. Thus, it would have been obvious to one of ordinary skill in the art to modify the bandage of Pocknell to provide the elastic layer as a stretchable loop fastener layer since doing so would allow the bandage to be wrapped and secured around a body part.

Pocknell and Docter do not expressly teach a method providing musculo-skeletal support; however, it has been held that the prior art inherently performs a claimed method when that prior art meets the structural limitations of the article of the claimed invention and is used in normal and usual operation (see MPEP 2112.02). It is considered normal and usual operation to stretch a stretchable wrap around a portion of the body then secure the wrap in a closed position with closure strips or fasteners. (Also see Docter's disclosure for mention of this operation in column 3, lines 8-14). Therefore, Pocknell in view of Docter anticipates the method of the claimed invention.

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In regard to Claim 7 and 12, the discussion for Claim 6 shows that Pocknell in view of Docter also meets the limitations for Claims 10 and 11. As also discussed for Claim 6, Pocknell discloses that the gel is a silicone gel.

In regard to Claim 8, Claim 8 is considered to a redundant limitation that is set forth in the last two lines of part (a) of claim 6. As discussed for Claim 6, the carrier is considered a stretchable loop portion.

In regard to Claim 9 and 14, Pocknell in view of Docter discloses the claimed invention but does not expressly disclose that the carrier having an elastic modulus of about 50%. Although Pocknell in view of Docter does not disclose an elastic modulus of about 50%, Pocknell in view of Docter again does teach a stretchable carrier layer. The elastic modulus of an object affects that objects ability to be stretched. Therefore, it would have been obvious to one of ordinary skill in the art to provide for a carrier with an elastic modulus of about 50%, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In regard to Claim 15, as discussed for Claim 10, Hook-and-loop type straps 16 are added to the elastic layer 12 of the wrap 10 to allow the bandage 10 be wrapped and secured around a body part by connecting elements 18 of the straps 16 to the elastic layer 12 (column 3, lines 8-22). Thus, the elastic layer of Docter is considered to be the stretchable loop portion of a hook-and-loop type fastener.

In regard to Claims 28-33 and 38, Pocknell in view of Docter discloses the claimed invention but does not expressly disclose that the bandage is wrapped around a joint or

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muscle and or further disclose that the joint is a knee, ankle, wrist, or an elbow. Pocknell in view of Docter also does not disclose intended uses for the wrap. However, Pocknell in view of Docter does disclose that the bandage is to be wrapped around a body part. Furthermore, it has been held that a recitation with respect to the manner in which a claimed invention is intended to be used does not differentiate the claimed invention from prior art satisfying the claimed structural limitations

In regard to Claims 34 and 39, Pocknell discloses that the silicone gel may be a cured polydiorganosiloxane resin (column 2, lines 2-32).

In regard to Claims 35 and 40, Pocknell discloses that the gel layer 2 may contain additives (column 2, lines 57-61).

In regard to Claims 37 and 42, Pocknell in view of Docter disclose previous limitations of the claimed invention but does not expressly disclose that the closure strip is approximately the width of the bandage.

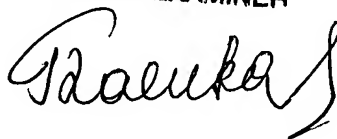
However, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the bandage of Pocknell in view of Docter with a closure strip that is approximately the width of the bandage, since the claimed invention has not disclosed that doing so provides an advantage, is used for a particular purpose, or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected the claimed invention to perform equally as with the bandage of Pocknell in view of Docter because Docter discloses that the closure strips 16 may sized and configured to support the bandage in a fixed position about a body part (column 3, lines 7-22).

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8. Claims 36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pocknell in view of Docter, in further view of Fabo (US 5,340,363).

In regard to Claims 36 and 41, Pocknell in view of Docter discloses the claimed invention but does not expressly disclose that the additive is a topical medication or emollient. Fabo discloses a supportive, stretchable bandage comprising a gel layer 2 and a stretchable carrier layer 1; the gel layer 2 may contain additives (column 2, lines 4-16; column 3, lines 30-36). Fabo '363 teaches that the gel layer may contain additives to relieve pain or stimulate wound repair (topical medicament). Pocknell in view of Docter and Fabo are analogous art because they are from the same field of endeavor: bandages comprising elastic and gel layers. Thus, it would have been obvious to one of ordinary skill in the art to modify Pocknell in view of Docter by incorporating additives into the gel layer as taught by Fabo since doing so would provide addition avenues for pain relief and wound repair stimulation for the patient.

TATYANA ZALUKAEVA
PRIMARY EXAMINER



Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keshia Gibson whose telephone number is (571) 272-7136. The examiner can normally be reached on M-F 8:30 a.m. - 6 p.m., out every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Keshia Gibson
Examiner, Art Unit 3761
klg 7/15/05